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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,214	10/13/2005	Masanao Kamei	5521-0117PUS1	8978
2292 7590 03/18/2010 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
SOROUSH, ALI				
ART UNIT		PAPER NUMBER		
1616				
NOTIFICATION DATE		DELIVERY MODE		
03/18/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/553,214

Applicant(s)

KAMEI ET AL.

Examiner

ALI SOROUSH

Art Unit

1616

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8, 29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgement of Receipt

Applicant's response filed on 11/16/2009 to the Office Action mailed on 06/15/2009 is acknowledged.

Status of the Claims

Claims 4 and 9-28 are cancelled, claim 1 is amended, and claim 30 is newly added. Therefore, claims 1-3, 5-8, 29 and 30 is currently pending examination for patentability.

Rejections and/or objections not reiterated from the previous Office Action are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of rejections and/or objections presently being applied to the instant application.

New Grounds of Rejection

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3, 5-8, 29 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended

independent claim 1 to read " a free organopolysiloxane", however Applicant has no support in the specification for a free organopolysiloxane.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 1-3, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartuska et al. (US Patent 4183366, Published 01/15/1980) in view of Kamei et al. (US Patent Application 2003/0185771 A1, Published 10/02/2003).

Applicant Claims

Applicant claims a method of conditioning hair by applying a composition comprising an organopolysiloxane to the hair.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

Bartuska et al. teach, "Henna based hair coloring and/or hair conditioning compositions comprising from about 75 to about 95 weight percent of henna powder,

from about 1.5 to about 5 weight percent of a non-ionic surface active agent, from about 2.5 to about 15 weight percent of a water soluble polymer and from about 0.5 to about 5 weight percent of a quaternary salt, and improved methods of coloring and/or conditioning hair using henna as the coloring and/or conditioning agent." (See abstract). In preferred embodiment the composition comprising: 85% henna powder, 5% polyvinylpyrrolidone K-90, 3% pluronic F-77, 2% lauryl pyridinium chloride, 5% titanium dioxide, q.s. fragrance. (See column 3, Lines 51-65).

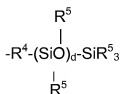
***Ascertainment of the Difference Between Scope the Prior Art and the Claims
(MPEP §2141.012)***

Bartuska et al. lacks a composition comprising a organopolysiloxane of formula 1. This deficiency is cured by the teachings of Kamei et al.

Kamei et al. teaches, "[A] powder composition comprising a silicone being represented by the following formula (1) having alcoholic hydroxyl groups and a powder ... and a cosmetic material comprising these:



In the formula, R^1 are an organic groups which may be the same or different chosen from t alkyl, aryl, aralkyl and fluorine-substituted alkyl groups having 1 to 30 carbon atoms, R^2 is a substituent having one or more alcoholic hydroxyl groups, R^3 is a group represented by the following formula (2),



wherein R^4 is an oxygen atom or bifunctional hydrocarbon group, and a, b, c, d are values satisfying the relations $1.0 \leq a \leq 2.5$, $0.001 \leq b \leq 1$, $0.001 \leq c \leq 1$, $1.5 \leq a+b+c \leq 2.6$, and d is integer $0 \leq d \leq 500$. " (paragraph 0012 and 0013). "This invention relates to a powder composition suitable for cosmetic materials, and in particular to a powder composition having excellent dispersibility comprising alcoholic hydroxyl groups treated by silicone compound, to a powder composition in oil obtained by dispersing this powder composition in oil, and to a cosmetic material containing these preparations." (See paragraph 0002). "Untreated powders tend to stick together due to charges and polarity on the powder surface and minute amounts of impurities, and this interferes with the dispersibility and stability of the powder." (See paragraph 0003). "It is therefore a first object of this invention to provide a powder composition having little cohesion and excellent dispersibility." (See paragraph 0008). "There is no particular limitation on the applications of the cosmetic material of this invention, but suitable examples which can be mentioned are skin care products, hair products, antiperspirants, makeup products and ultraviolet light protection products. In addition, there is no particular limitation on the form of the product, but it may be in the form of a liquid, cream, solid, paste, gel, powder, laminate, mousse or spray." (See paragraph 0080).

***Finding of Prima Facie Obviousness Rational and Motivation
(MPEP §2142-2143)***

It would have also been obvious to one of ordinary skill in the art at the time of the instant invention to combine the teachings of Bartuska et al. and Kamei et al. One would have been motivated to add silicone compound of formula 1 taught by Kamei et al. to the composition taught by Bartuska et al. One would have been motivated to do so

in order to provide improved dispersibility and stability to the powder in the cosmetic composition taught by Bartuska et al. For the foregoing reasons the instant invention would have been obvious to one of ordinary skill in the art at the time of the instant invention.

2. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartuska et al. (US Patent 4183366, Published 01/15/1980) in view of Kamei et al. (US Patent Application 2003/0185771 A1, Published 10/02/2003) further in view of Nomura et al. (UK Patent Application 2138845 A, Published 10/31/1984).

Applicant Claims

Applicant claims a method of conditioning hair by applying a composition comprising an organopolysiloxane to the hair. The method further comprising applying a second composition comprising an amino-modified silicones.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

The teachings of Bartuska et al. and Kamei et al. are discussed above.

Ascertainment of the Difference Between Scope the Prior Art and the Claims (MPEP §2141.012)

The teachings of Bartuska et al. and Kamei et al. lack a teaching wherein a second composition comprising an amino-modified silicone is applied to the hair. The teaching of Nomura et al. cures this deficiency.

Nomura et al. teaches a hair dye composition containing amino-modified silicone,. (See abstract). Amino-modified silicones represented by formula I. (See

abstract). The hair dye treatment is applied for 30 minutes and then thoroughly washed with a secondary composition and water. (See page 6, Lines 15-20).

***Finding of Prima Facie Obviousness Rational and Motivation
(MPEP §2142-2143)***

It would have been obvious to one of ordinary skill in the art to combine the teachings of Bartuska et al. and Kamei et al. with Nomura et al. One would have been motivated to do so because Nomura et al. teaches that after the application of the bleaching and dyeing composition, the hair should be washed. For the foregoing reasons, the instant invention would have been obvious to one of ordinary skill in the art at the time of the instant invention.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Soroush whose telephone number is (571) 272-9925. The examiner can normally be reached on Monday through Thursday 8:30am to 5:00pm E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ali Soroush
Patent Examiner
Art Unit: 1616

/Johann R. Richter/

Art Unit: 1616

Supervisory Patent Examiner, Art Unit 1616